UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte BARRY C. MUFFOLETTO and ASHISH SHAH

Appeal No. 2004-1624
Application No. 09/628,174

ON BRIEF

Before PAK, WARREN, and TIMM, *Administrative Patent Judges*.

PAK, *Administrative Patent Judge*.

REQUEST FOR REHEARING

This is a decision on appellants' request for rehearing of our earlier decision entered July 21, 2004, wherein we affirmed the examiner's final rejection of claims 6 and 7 under 35 U.S.C. § 102(b).

The appellants argue that our earlier decision entered July 21, 2004 is erroneous since it has misapprehended *In re Luck* and failed to give appropriate weight to the claimed process limitation "by low temperature arc vapor deposition" in the claims

on appeal. See the Request for Rehearing dated September 23, 2004, pages 1-2. We do not agree.

As is apparent from pages 2 through 4 of our earlier decision, we have properly considered *In re Luck* and its related decisions and properly weighed the claimed process limitation. Specifically, in citing *In re Thorpe* and *In re Pilkington*, we have stated that "'If the product in a product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior art product was made by a different process.'" See pages 3 and 4 of our earlier decision. We have then explained at page 4 of our earlier decision referring to *In re Luck* that

> this [statement] does not mean that process limitations in a product-by-process claim can be ignored in all circumstances. They must be considered if they contributed [sic, contribute] to the compositional and/or structural attributes of the claimed substrate.

However, as we have discussed at pages 4 and 5 of our earlier decision, *In re Brown* and *In re Fessman* permit a comparison between the claimed and prior art substrates themselves to establish a *prima facie* case of unpatentability. Indeed, consistent with *Luck*, *Brown*, *Fessman* and *Thorp*, the court in *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1972) explained that to establish a *prima facie* case of unpatentability of the claimed product, the examiner can show similarities of the

identities of the claimed and prior art products through comparing the products themselves and/or comparing the processes by which they are made. *See also In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990).

Applying the above precedents to the present case, we have determined at pages 5 through 7 of our earlier decision that substantial evidence supports the examiner's finding that the claimed and prior art substrates are either identical or substantially identical. This is so because "the substrate described in Evans is made of the same components as that claimed and has the same property and utility (electrically conductive property and capacitor electrode utility) as that claimed." See page 7 of our earlier decision.

For the reasons set forth at pages 5 through 7 of our earlier decision, we have determined that the examiner has supplied a sufficient factual basis to establish a *prima facie* case of unpatentability of the claimed substrate within the meaning of 35 U.S.C. § 102(b). It is, therefore, incumbent upon the appellants to prove by objective evidence that the claimed process limitation, in fact, renders the claimed substrate patentably different from the substrate described in Evans. However, as indicated at pages 6 and 7 of our earlier decision, the appellants, on this record, have not met their burden of proof.

The appellants argue that our decision has misapprehended objective evidence in the application. See the Request for Rehearing dated September 23, 2004, page 3. In support of this argument, the appellants for the first time rely on a conclusory statement at page 3, lines 12-14, of the specification, which is provided below (*Id.*):

> The method **can be** performed at a temperature sufficiently low so as to prevent substrate degradation and deformation. (Emphasis added).

According to the appellants (*Id.*), the appellants' own conclusory statement in the specification constitutes objective evidence which is sufficient to rebut the *prima facie* case established by the examiner.

We decline to consider this conclusory statement in the specification since the appellants have not relied on it in the Brief and the Reply Brief.[1] See the Brief and the Reply Brief in their entirety. Nor have the appellants shown "good cause" why we should consider it in the first instance.[2] *Id.*

Even were we to consider this conclusory statement, it would not rebut the *prima facie* case established by the examiner for various reasons. First, we find that the appellants' conclusory statement in the specification is not supported by any factual

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[1] See 37 CFR § 41.37(c)(vii)(2004); 37 CFR § 1.192(a)(2003).

[2] See 37 CFR § 41.37(c)(vii)(2004); 37 CFR § 1.192(a)(2003).

evidence. *Luck*, 476 F.2d at 650, 177 USPQ at 525("Appellants' affidavit alleging the use of an aqueous vehicle would result in an 'extremely poorly adherent and unsatisfactory' coating fails to provide the rebuttal evidence necessary to overcome this prima facie case. As pointed out by the examiner, no comparative tests are presented for evaluation."); *see also De Blauwe*, 736 F.2d at 705, 222 USPQ at 196 (Mere arguments in the Brief or conclusory statements in the specification cannot take the place of objective evidence.). The appellants simply have not demonstrated that exposing the high temperature resistance metal substrate disclosed in Evans to an elevated temperature for a very short period, e.g., 30 seconds, causes degradation and deformation. Indeed, the evidence of record is to the contrary as Evans does not indicate that it observes any degradation and deformation on its substrate. See Evans in its entirety.

Second, the claimed process limitation "by low temperature arc deposition" does not require that the claimed substrate be formed at a temperature below those disclosed in Evans. See the specification in its entirety. Specifically, it is not defined to exclude the heat treatment condition taught by Evans. See page 2 of our earlier decision. Nor is there any evidence on this record to show that "low temperature arc deposition" excludes the temperature condition taught by Evans. *Id.* Moreover, the claims are open-ended and do not preclude additional process limitations,

including a subsequent heat treatment step corresponding to that disclosed in Evans. See, e.g., claim 6 on appeal.

CONCLUSION

In light of the foregoing, the appellants' request for rehearing is granted to the extent of reconsidering our earlier decision, but is denied with respect making any change thereto.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REQUEST FOR REHEARING-DENIED

CHUNG K. PAK)
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